

Appl. No. 10/820557
Amdt. Dated 3-11-06
Reply to Office Action of 12-08-05

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application. Applicant has amended the independent claims to overcome the 112 rejections pointed out by the examiner.

Applicant respectfully submits the examiner has failed to present a *prima facie* case of obviousness because the examiner has failed to analyze all of applicant's claimed recitations by not adequately identifying all of applicant's claimed recitations in the prior art of record. The examiner has merely provided a cursory statement that the Tonnesen and Swan references render applicant's claimed invention to be obvious without providing reference numerals or guidance on how the examiner has made such a conclusion. Should the examiner maintain a position of unpatentability, applicant respectfully requests the examiner to point out with particularity all of applicant's claimed recitations so that applicant can understand how the examiner has reached such a conclusion.

Original Claims are Patentable

No prior art of record teaches or renders obvious the following claimed recitations:

Regarding Independent claims 1, 7 and 12

- *said body being formed from one-way viewing material for providing a line of sight extending outwardly through a window but not extending inwardly therethrough;*

Applicant respectfully submits the examiner has mischaracterized applicant's statement on page 4 of the specification; "Of course, many conventional one-way viewing materials may be employed by the present invention such as one-way viewing plastics, for example, as well known to a person of ordinary skill in the art." Such a statement merely states conventional one-way viewing materials may be employed. The statement does not mean that it is obvious to one skilled in the art to employ one-way viewing materials for windows.

Appl. No. 10/820557
Amdt. Dated 3-11-06
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- *one said plurality of rods being movable substantially transversely to the axis between expanded and retracted positions for moving said body between stretched and non-stretched positions respectively;* Swan's rods are movable parallel to the axis (see FIG. 1). Tonnesen's rods are secured to a pair of jaws 15 and shank 16 such that their free ends will not permit movement of passage of bead 5 (see column 2, lines 42-55). In fact, Tonnesen specifically recites that the bead slides "in a direction parallel to the axis of the bore defined by the arms 15." (column 2, lines 54-55). This movement necessarily and inherently prevents Tonnesen's beam 5 from moving transverse to the axis, as claimed by the applicant.

- *one said plurality of brackets having a plurality of notches formed therein for simultaneously supporting said plurality of rods during non-use conditions.* Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant. None of Tonnesen's brackets can simultaneously support its plurality of rods (see FIGS. 1 and 2), as claimed by the applicant.

- *wherein said plurality of brackets comprise:*
a flange portion having an aperture for receiving a fastening member therethrough respectively; and
an arcuate portion integral with said flange portion and for defining a slot through which said plurality of rods can be positioned respectively; Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant.

- *wherein said body is wound about one said plurality of rods;* Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant.

Appl. No. 10/820557
Amdt. Dated 3-11-06
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Amended Claims are Patentable

Should the examiner find applicant's arguments unpersuasive, applicant respectfully submits the following newly claimed recitations clearly place the present invention in condition for allowance.

Applicant has amended the claims to more narrowly distinguish the present invention over the prior art of record. Applicant respectfully submits no new matter has been introduced, which would affect the statutory requirements of patentability, because all newly claimed recitations are clearly supported by the original drawings. A person of ordinary skill in the art is enabled to make and use the presently claimed invention based on the originally filed drawings. Applicant has included case law, wherein the Court has held the claims may be amended based upon the originally filed drawings without triggering a new matter rejection (please see attached literature).

Regarding Independent Claim 12

- *another one of said plurality of rods being statically conjoined to said one plurality of brackets in such a manner that said another rod remains stationary as said one rod is traversed towards and away therefrom;* Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant.
- *said one rod being juxtaposed adjacent to said another rod at one side of the window after said one rod is traversed to said another rod;* Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant.
- *wherein each bottom end of said plurality of rods are countersunk into selected ones of said plurality of notches while each top end of said plurality of rods are exposed above associated ones of said plurality of notches.* Neither Tonnesen nor Swan provide any teaching, suggestion or motivation to provided such a structural relationship, as claimed by the Applicant.

Appl. No. 10/820557
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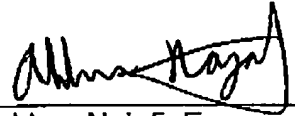
In view of these considerations, it is respectfully submitted that the rejection of the pending claims should be considered as no longer tenable with respect to the above mentioned arguments and claim amendments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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1068

Patent Prosecution

Ch. 8.IV.B

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for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the later are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.⁴⁹²

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The CCPA remarked that the originally filed specification described the step of applying the adhesive as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums."⁴⁹³ The specification thus described one method of adheringly applying the various layers in the thermal insulation. On the basis of this description, the CCPA held that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered. Thus the phrase 'adheringly applying' is supported by the example found in the specification."⁴⁹⁴

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Rasmussen therefore teaches that an original claim and examples in the specification may be used to support amendments after the application is filed.

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*C. Drawings That Provide Support for Amendments to Specification

Drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. *In re Wolfensperger*⁴⁹⁵ is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In *Wolfensperger*, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a "packing ring" in "untensioned condition" that included "a mean diameter corresponding approximately to the mean diameter of said chamber."⁴⁹⁶

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On appeal, the CCPA reversed. The court disagreed with the Board's statement that it was well-established legal precedent that

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⁴⁹²*Id.*, 211 USPQ at 326 n.5 (citing *In re Anderson*, 471 F.2d 1237, 1238, 176 USPQ 331, 332 (C.C.P.A. 1973)).

⁴⁹³*Id.*, 211 USPQ at 326.

⁴⁹⁴*Id.*, 211 USPQ at 327 (footnote omitted) (emphasis in original).

⁴⁹⁵*In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962).

⁴⁹⁶*Id.*, 133 USPQ at 538.

Ch. 8.IV.D

Disclosure

1069

drawings alone cannot constitute a written description of the invention. The CCPA stated as follows in this connection:

Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case.⁴⁹⁷

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."⁴⁹⁸

The CCPA held that figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber.⁴⁹⁹ On this basis, the court held that the application satisfied the written description requirement. Thus, *Wolfensperger* teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.



D. New Matter and Correcting Obvious Errors

An applicant may generally correct obvious errors in the application without introducing prohibitory new matter. For example, translation errors from foreign prior applications may generally be corrected.⁵⁰⁰ The general rule is that if the error can be detected and corrected by one of ordinary skill in the art, then the applicant may amend the application to correct the error without introducing new matter.⁵⁰¹

*Ex parte Brodbeck*⁵⁰² is an example of when an applicant was permitted to amend the specification to correct an obvious error. In *Brodbeck*, the invention related to a process of catalytic isomerization of a compound. Brodbeck sought to reissue his already-granted patent, U.S. Patent Number 3,647,898, by amending the claim portion of the application. The original claim 1 of the issued patent recited the lim-

⁴⁹⁷*Id.*, 133 USPQ at 541-42.

⁴⁹⁸*Id.*, 133 USPQ at 542 (emphasis in original).

⁴⁹⁹*Id.*, 133 USPQ at 541.

⁵⁰⁰*See In re Oda*, 443 F.2d 1200, 170 USPQ 268, 272 (C.C.P.A. 1971).

⁵⁰¹*Id.*

⁵⁰²*Ex parte Brodbeck*, 199 USPQ 230 (Pat. Off. Bd. App. 1977).